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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Nitin J. Shah

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EXAMINER

DAO, MINH D

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/745,493	Applicant(s) SHAH, NITIN J.	
	Examiner MINH D. DAO	Art Unit 2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the obvious suggestion of Chmaytelli is to set the functionality combinations of the device of Chmaytelli, as allowed by Chmaytelli, in order to obtain more options that fulfill the needs of the users.

2. Applicant's arguments filed 01/09/2006 have been fully considered but they are not persuasive.

In response to applicant's argument on page 2 of the remarks filed 01/09/2006 regarding claim 1, rejection of claim 1 has been revised using the same cited reference Chmaytelli to point out where and why Chmaytelli obviously reads on the limitations of the claim.

In response to applicant's argument on page 3 of the remarks regarding claim 9, examiner clearly point out where and why Chmaytelli obviously reads on the limitations of claim 9. Please refer to office action dated August 16, 2005.

Regarding claim 20, applicant, on page 4 of the remarks filed 01/09/2006, argued that non of Chmaytelli or Nakamura teachings teaches that "... , and a second mode of operation, where the local functionality is provided and the communication functionality is disabled." as recited in claim 20. Examiner disagrees. This limitation is not recited in claim 20.

DETAILED ACTION

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19, 22-26, 28-39, 41-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (US 6,233,464).

Regarding claim 9, Chmaytelli teaches a method for selectively disabling the wireless communication functionality of an integrated portable computing-communication device (see figs 1 and 2; col. 2, lines 25-34, lines 47-50), the method comprising: providing a first mode of operation in which both wireless communication functionality and local functionality of the device are enabled (see col. 3, lines 34-45; see option 1 where the PDA and the telephone are on when the stylus is removed); providing a second mode of operation in which the communication functionality is disabled and the local functionality is enabled (see col. 3, lines 34-45, line 45). In this case, since other options, may be offered as required, can be set by the user (see col. 2, lines 6-24), it is obvious that the system of Chmaytelli is capable of providing a second mode of operation in which the communication functionality is disabled and the local functionality is enabled); and selectively switching between the first and second modes of operation (as stated in col. 3, lines 34-45, the action of removing and replacing the stylus into its holder creates at least two modes of operations.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to set the functionality combinations of the device of Chmaytelli, as allowed by Chmaytelli, in order to obtain more options that fulfill the needs of the user.

Regarding claim 10, Chmaytelli teaches the method of claim 9, further comprising providing a third mode of operation in which neither the wireless communication functionality nor the local functionality of the device is enabled (see col. 3, lines 43-45).

Regarding claim 11, Chmaytelli teaches the method of claim 9, wherein selectively switching between the first and second modes of operation comprises: in the first mode of operation, providing power to a computing unit and a radio communication unit of the integrated portable computing-communication device, wherein the computing unit provides the local functionality and the radio communication unit provides the communication functionality; and in the second mode of operation, providing power to the computing unit, and not providing power to the communication unit (reference Chmaytelli, col. 3, lines 33-35, when the PDA and the telephone are on; also see figs. 2,3,4).

Regarding claim 12, Chmaytelli teaches the method of claim 9, wherein selectively switching between the first and second modes of operation comprises disabling at least a portion of a radio communication unit that provides the communication functionality in the second mode of operation (see col. 6, lines 6-24).

Regarding claims 13-16, the cellular communication technology is inherently known to provides data transfer between the mobile units and a network that is capable of carrying data, voice and Internet communication so that in the first mode of operation, the wireless telephone of Chmaytelli would provide the capabilities mentioned above for the benefit of pleasing cellular customers with variety of choices to communicate from one party to another.

Regarding claim 1, the rejection of claim 9 is herein incorporated. In addition, Chmaytelli also teaches a power supply (see figs. 3,4), a computing unit (see figs. 3,4) and a switch (see fig. 2).

Regarding claim 2, the claim has the limitation as that of claim 13, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 13.

Regarding claims 3,4,5,6,7, Chmaytelli teaches the computing unit comprises: a data storage area to store information; and a processor, coupled to the data storage area to retrieve the information, and the information includes ROM and RAM information (see the PDA in fig. 2 of Chmaytelli). In addition, it is inherently known in the art that memory of an PDA should contain ROM and RAM information in order to accept and process the information.

Regarding claim 8, it is inherently known in the art that the base station within an cellular system should be adaptive array in order to handle call hand-offs from one base station to another.

Regarding claim 17, the claim is the apparatus claim of claim 9, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 9.

Regarding claim 18, Chmaytelli teaches the apparatus of claim 17, wherein the selection means comprises a switching means to switch between the first and second modes of operation (see figs. 2,3, and 4 of Chmaytelli).

Regarding claim 19, Chmaytelli teaches the apparatus of claim 18, wherein the switching means is coupled to a power supply means, the switching means to disable the supply of power from the power supply means to at least a portion of the second means (see figs. 2,3, and 4 of Chmaytelli).

Regarding claim 22, Chmaytelli teaches the apparatus of claim 17, further comprising an indication means for indicating whether the apparatus is operating in the first or the second mode of operation (see Chmaytelli, col. 2, lines 6-18).

Regarding claim 23, the claim has the limitations as that of claims 9 and 17, therefore it is interpreted and rejected for the same reason set forth in the rejections of claim 9 and claim 17.

Regarding claim 24, the claim has the limitation as that of claim 12, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 12.

Regarding claim 25, the claim has the limitation as that of claim 19, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 19.

Regarding claim 26, the claim has the limitation as that of claim 19, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 19. In addition, once the power supporting the radio communication is turned off the entire RF circuitry should be off including the oscillator.

Regarding claim 28, the claim has the limitation as that of claim 26, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 26.

Regarding claims 29 and 30, the claims have the limitation as that of claim 26, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 26. Similar to rejection of claim 26, when the power supporting the radio communication is turned off the entire RF circuitry should be off including the antenna.

Regarding claims 31 and 32, Chmaytelli does not mention disabling access to making and receiving calls by increasing the shielding of the antenna. However, it is inherently known in the art that when an antenna is retracted from its operating extended position into its housing, the housing will act as shielding mechanism to prevent radio waves from transmitting/receiving to/from a communication device.

Regarding claim 33, Chmaytelli teaches disabling the access to the making and receiving wireless calls comprises disabling the access in response to selection of a soft key on the device (see fig. 2 of Chmaytelli, in this case the stylus action trigger and the switch reads on the soft key of the device).

Regarding claim 34, Chmaytelli teaches disabling the access to the making and receiving wireless calls comprises disabling the access in response to toggling of a mechanical switch on the device (see fig. 2 of Chmaytelli, also see col. 2, lines 6-18).

Regarding claim 25, the claim has the limitation as that of claim 34, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 34.

Regarding claim 36, the claim has the limitation as that of claim 13, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 13.

Regarding claim 37, the claim has the limitation as that of claim 23, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 23.

Regarding claim 38, the claim has the limitation as that of claim 26, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 26.

Regarding claim 39, the claim has the limitation as that of claim 19, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 19.

Regarding claim 41, the claim has the limitation as that of claim 29, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 29.

Regarding claim 42, the claim has the limitation as that of claim 33, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 33.

Regarding claim 43, the claim has the limitation as that of claim 34, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 34.

Regarding claim 44, the claim has the limitation as that of claim 35, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 35.

Regarding claim 45, the claim has the limitation as that of claim 17, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 17.

Regarding claim 46, the claim has the limitation as that of claim 24, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 24.

Regarding claim 47, the claim has the limitation as that of claim 26, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 26.

Regarding claim 48, the claim has the limitation as that of claim 24, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 24.

Regarding claim 49, the claim has the limitation as that of claim 29, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 29.

Regarding claim 50, the claim has the limitation as that of claim 30, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 30.

Regarding claim 51, the claim has the limitation as that of claim 31, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 31.

Regarding claim 52, the claim has the limitation as that of claim 35, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 35.

Regarding claim 53, the claim has the limitation as that of claim 26, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 26.

Regarding claim 54, the claim has the limitation as that of claim 1, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 1.

Regarding claim 55, the claim has the limitation as that of claim 47, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 47.

Regarding claim 57, the claim has the limitation as that of claim 23, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 23. In addition, Nakamura teaches detecting an event that is when the mobile unit enters a restricted area its power is turned off.

Regarding claim 58, the claim has the limitation as that of claim 48, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 48.

Regarding claims 59,60,61,62, the claims have the limitation as that of claim 48, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 48.

Regarding claim 63, Chmaytelli teaches the method of claim 57, wherein detecting the event comprises detecting a user input (see Nakamura, col. 3, lines 14-23).

Regarding claim 64, the claim has the limitation as that of claim 36, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 36.

Regarding claim 65, the claim has the limitation as that of claim 9, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 9 regardless of where the application is implemented.

Regarding claims 66 and 67, see fig.2 of Chmaytelli.

Regarding claim 68, the claim has the limitation as that of claim 53, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 53.

5. Claims 20, 21, 27, 40, 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (US 6,085,096) in view of Nakamura (US 6,085,096).

Regarding claim 20, Chmaytelli, as atated above, teaches the apparatus of claim 17. However, Chmaytelli fails to teach that the external entity triggers the selection means to select between the first and second modes of operation. Nakamura, in an analogous art, teaches a mobile communication system that can be powered off by an associated base station when the mobile entering an restricted area (see fig. 7 of Nakamura, base station 31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Nakamura to Chmaytelli in

order to prevent the mobile communication system from disturbing the restricted area as taught by Nakamura.

Regarding claim 21, the combination of Chmaytelli and Nakamura teaches the apparatus of claim 20, wherein the external entity comprises a transmitter to transmit a signal that triggers the selection means to select between the first and second modes of operation (see fig. 7 of Nakamura, col. 6, lines 13-26).

Regarding claim 27, the combination of Chmaytelli and Nakamura teaches the method of claim 26, wherein disabling the local oscillator of the RF unit comprises sending a software command to a local oscillator control circuit to cause the local oscillator to cease operation (see fig. 7 of Nakamura, also see col. 6, lines 3-26, and the explanation of the rejection of claim 26 above).

Regarding claim 40, the claim has the limitation as that of claim 27, therefore it is interpreted and rejected for the same reason set forth in the rejection of claim 27.

Regarding claim 69, the combination of Chmaytelli and Nakamura teaches the method of claim 65, wherein the trigger received at the device comprises a signal received automatically from an external entity (see Nakamura, col. 3, lines 32-37).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is 571-272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dao *MD*
AU 2618
March 09, 2006



Matthew Anderson
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